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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,717	08/22/2000	Kenji Kimura	PM268729	3228

7590

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EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,717

Applicant(s)

KIMURA ET AL.

Examiner

Rabon Sergent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "may" within line 12 (the structures each being one line) renders the claims indefinite because it is not clear if or to what extent the language denoted by "may" is optional.

2. Claim 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, within claim 12, it is questioned if the language, "amide is compounded 0.01 part ...", is correct.

Secondly, within claims 12 and 13, applicants have failed to set forth a basis for the parts by weight.

3. Claims 7, 8, and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Despite applicants' remarks, the position is taken that adequate support has not been provided for claim 7, as amended. The examiner has found support only for the embodiment where the specific additives display an anti-leaching property. There appears to be nothing on the record to indicate that the anti-leaching characteristic of the specific additives is conveyed to all ingredients compounded within the composition.

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4. Claims 7, 8, and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Despite applicants' response, applicants have failed to provide enablement for the claim language pertaining to "improving the anti-leaching property of polyurethane" as it pertains to components other than the specific additives disclosed within example 2 of the specification. Example 2 appears to be concerned with comparing the fugitive or leaching characteristics of the stabilizers within the polyurethane, when the polyurethane is subjected to dyeing and the accompanying extraction properties associated with dyeing. It is not seen that the example provides enablement for anything other than demonstrating the relative degrees that the respective stabilizers will leach out of the polyurethane. Therefore, the claim is not enabled for the concept of modifying the polyurethane so that any component within the polyurethane will be less likely to leach out after treatment. The rejection of claim 8 has been maintained as it depends from claim 7 and therefore carries the limitations of claim 7.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2, 3, and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 46-27874 in view of Ishii et al. ('744) or JP 6-93070 or JP 57-108154.

The primary reference discloses the use of a long chain amide compound, corresponding to that of applicants' formula I, which is used as a polyurethane discoloration stabilizer. The reference specifically discloses that the stabilizer reduces the discoloration effects resulting from exposure to NO₂. Furthermore, the reference specifically addresses the addition of the stabilizer to Spandex filaments; therefore, the position is taken that the reference clearly encompasses the treatment of fibers and yarns. See abstract.

7. The primary reference is silent regarding the use of hindered phenol antioxidants; however, hindered phenols were known polyurethane antioxidants at the time of invention. This position is supported by the teachings of the secondary references.

8. Since it has been held that it is *prima facie* obvious to utilize known ingredients for their known functions (*In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.) and to

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combine individual components, each of which is known to be useful for the same purpose, to form a composition which is to be used for the very same purpose (*In re Kerkhoven*, 205 USPQ 1069), the position is taken that it would have been obvious to utilize both an amide stabilizer and a hindered phenol stabilizer within a polyurethane, so as to arrive at the instant invention. Given the position taken within paragraph 3, the position is further taken that the process of claims 7 and 8 is essentially drawn to a process of adding the respective stabilizers to a polyurethane. It is not seen that the language of the preamble contributes a patentable distinction to the claims or "breathes life" into the claims.

9. Applicants' arguments have been considered. Initially, the examiner notes that the abstract of JP 46-27874 clearly pertains to preventing discoloration of a polyurethane by compounding an amide with the polymer. Furthermore, the position is maintained that it would have been obvious to utilize the known compounds for their art recognized utilities, namely for their capabilities pertaining to stabilizing polyurethane and preventing discoloration. Furthermore, applicants' argument that one would not have had a reasonable expectation of success, based on the results within Table 2 of Ishii et al. indicating that some compounds perform less well than others, continues to not be well taken. Rather, the position is maintained that the results of the table serve to provide one with guidance in determining how to use the disclosed compounds. The examiner's view of the table is that it serves to teach that select compounds are more suitable when used in admixture. It is noted, firstly, that the table discloses compounds, which fall within the purview of applicants' compounds, that give excellent results

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and, secondly, that applicants' claims in no way exclude additional components. In fact, a large portion of applicants' specification is drawn to disclosing additional stabilizing components that may be incorporated within the compositions. The position is ultimately taken that a *prima facie* case of obviousness has been set forth and that applicants have failed to adequately rebut the *prima facie* case.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
June 30, 2003


RABON SERGENT
PRIMARY EXAMINER